



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

Paper No. 6

COPY MAILED

AUG 1 2 2002

CANTOR COLBURN, LLP
55 GRIFFIN ROAD SOUTH
BLOOMFIELD, CT 06002

In re Application of
Moussy, et al.
Application No. 10/066,393
Filed: January 31, 2002
Attorney Docket No.: 98-2163-P
For: APPARATUS AND METHOD FOR
CONTROL OF TISSUE/IMPLANT
INTERACTIONS

:
:
:
:
:
:
:

OFFICE OF PETITIONS
DECISION DISMISSING
PETITION UNDER 37 CFR
1.47(a)

This is in response to the petition under 37 CFR 1.47(a), filed
June 3, 2002.

The petition is **DISMISSED**.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. Failure to respond will result in abandonment of the application. Any extensions of time will be governed by 37 CFR 1.136(a).

The above-identified application was filed January 31, 2002 without an executed oath or declaration and naming Francis Moussy, Donald Kreutzer, Diane Burgess, Jeffrey Koberstein, Fotios Papadimitrakopoulos, and Samuel Huang as joint inventors. Accordingly, on February 27, 2002, a "Notice to File Missing Parts of Application" was mailed, requiring an executed oath or declaration, and a surcharge for its late filing.

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor, or in the present case, the non-signing legal representative of the deceased inventor, cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

Applicant lacks requirement (1) set forth above. The petition lacks sufficient evidence that the non-signing inventor cannot be reached, was ever presented with a copy of the application papers (specification, claims, drawings, and oath or declaration), or, having been presented with the application papers, refused to sign the oath or declaration.

Margaret M. Genest states she sent a Declaration/Power of Attorney to the non-signing inventor on March 20, 2002 and that on April 15, 2002, she spoke with the inventor wherein he stated "he was not going to sign anything from UConn as UConn had broken their contract with him." Petitioner has included a copy of an e-mail dated April 17, 2002 from the inventor wherein the inventor states

he had would not sign the Power of Attorney until he had adequate time "to consider the implications of such an action."

Petitioner is reminded that before a refusal to sign an oath or declaration can be alleged, it must be demonstrated that a *bona fide* effort has been made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the non-signing inventor. Petitioner has failed to establish that the inventor received a complete copy of the application papers (specification, claims, drawings, oath and declaration) and thereafter refused to sign the oath or declaration. Petitioner has merely established that the inventor was sent a Declaration/Power of Attorney. There is some question as to whether this in fact was even received by the inventor as the copy of an e-mail dated April 15, 2002 from Margaret M. Genest to Michael Newborg indicates the inventor did not acknowledge receiving the Declaration/Power of Attorney.

A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the non-signing inventor is represented by counsel, to the address of the non-signing inventor's attorney. See, MPEP 409.03(d).

Any renewed petition should be accompanied by evidence to sufficiently establish that the non-signing inventor either cannot be located or that the non-signing inventor was sent a complete copy of the application papers and thereafter refused to execute the declaration. Petitioner may wish to provide the Office copies of letters sent to the inventor indicating the enclosure of the application papers (specification, claims, drawings, and oath or declaration). If after the inventor receives the application papers and requests to execute the oath or declaration are refused, these facts should be set forth in a statement of facts signed by the person to whom the refusals were made and detailing with specificity the exact manner of the refusals. If a written refusal has been made, a copy of the written refusal should be included on renewed petition.


Further correspondence with respect to this matter should be addressed as follows:

By mail: Commissioner for Patents
Box DAC
Washington, DC 20231

By FAX: (703) 308-6916
Attn: Office of Petitions

By hand: Crystal Plaza Four, Suite 3C23
2201 S. Clark Place
Arlington, VA

Telephone inquiries related to this decision may be directed to the undersigned at (703) 305-0310.


Alesia M. Brown
Petitions Attorney
Office of Petitions
Office of the Deputy Commissioner
for Patent Examination Policy